

REMARKS

This amendment with Request for continued Examination is in response to the Final Office Action of May 14, 2007 in which claims 1-37 were rejected.

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In the Amendment submitted in this communication with the USPTO Office, various of the previously presented claims are changed in ways believed related only to matters of form. For example, some reference numerals/labels are removed from the claims, which change does not affect the scope of the claims per MPEP § 608.01(m) which states that "The use of reference characters is considered as having no effect on the scope of the claims".

Also independent claims 1, 19 and 36 are amended to clarify the invention to obviate the Examiner's rejection. In addition, claims 8-41 are added (having similar scope as previously presented claims). All amendments are fully supported by the specification. Claims 1, 27, 34-35 are cancelled.

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In Section 4, claims 1-18 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant disagrees with Examiner as was articulated in the previous communications with the Patent Office in Request for Reconsideration of February 21, 2207, in Amendment B of September 27, 2006 and in Request for Reconsideration of November 23, 2005. Indeed, claim terminology can and should rely on the definition provided in the specification as

clearly described in MPEP paragraphs 608.01(o), 2111, 2111.01 and 2173.05(a).

Nevertheless the Applicant amends independent claims 1, 19 and 36 to clarify the meaning of the word "forwarding" as well as further clarify the invention.

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In Section 6, claims 1-34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kalke, U.S. Patent Application Publication 2004/0137890 and Muramatsu et al. (US Patent Application Publication 2006/0155803) in view of Martin, JR. et al., U.S. Patent Application Publication 2003/0023849 (hereinafter Martin et al.).

Even in light of the amended independent claims, the applicant believes the arguments presented in the previous communications with the Patent Office in Request for Reconsideration of February 21, 2207, in Amendment B of September 27, 2006 and in Request for Reconsideration of November 23, 2005 are valid.

Furthermore, the applicant would like to stress a few additional points.

First, none of the references quoted by the Examiner teach "chain of trust comprising at least two consecutive exchanges of information between trusted elements of the network and the terminal" as recited in the amended independent claims 1, 19, 36 and 38 of the present invention. Furthermore, it is satated by the Examiner in Section 47 of the Final Office Action of May 14, 2007 that Martin et al. "teach delegation of provisioning by Trusted Provisioning Domains (TPDs) that are coupled to network 3, hence forming a chain of trusted domains that are part of the network 3." There is a confusion here: primary TPD 5

and secondary TPDs 6-1 ... 6-M of Martin et al. are not parts of the network 3, whereas independent claims 1, 19, 36 and 38 clearly stated that "chain of trust comprising at least two consecutive exchanges of information between trusted elements of the network and the terminal". Martin does not teach that explicitly or implicitly. The reference of Martin et al. is totally different than the teachings of the independent claims 1, 19, 36 and 38 of the present invention. Indeed, Martin et al. disclose delegation of authority of the trusted provisioning domains from one to another domain outside of network 3 (to secondary trusted provisioning domains) as shown in figure 1 of Martin et al. (also see claim 1 of Martin et al.).

Moreover, if we draw a parallel between trusted provisioning domain (TPD) of Martin et al. and present invention, TPD of Martin I equivalent to a provisioning server 28 (Figure 1 of the present invention) or to a device management server 28a (Figure 1 of the present invention) which are for provisioning the terminal. The difference with TPDs of Martin et al. is that modules 28 and 28a of the present invention are not "trusted", but the chain of trust is established by a different method as disclosed in the independent claims 1, 19, 36 and 38 of the present invention using "plug and play" methodology.

Also it is noted by the applicant that many specific limitations of dependent claims are not disclosed by the references quoted by the Examiner, contrary to what is alleged by the Examiner.

For example, in section 29 of the Final Office Action of May 14, 2007, the Examiner's reference to Kalke as describing specific steps/modules/functions of claims 9 and

23 of the present invention is inaccurate, because Kalke does not disclose these steps/modules/functions: by only mentioning by Kalke the name of the elements recited in claim 9 of the present invention does not imply that Kalke discloses the functionality of these elements as recited in claims 9 and 23, contrary to what is alleged by the Examiner.

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Furthermore, in regard to combining references, the applicant strongly disagrees with the Examiner and refer to arguments made in the previous communications to the Patent Office as quoted above.

The approach taken by the Examiner will render any patent issued in the past or in the future invalid because practically any invention comprises elements which are already known. The issue is not that it would be obvious to a person skilled in the art to combine selected elements from different references in the hindsight, as alleged by the Examiner, but why this combining is needed and what problem is solved by doing so, such that said person skilled in the art would be motivated to combine and modify the quoted references to arrive at the subject matter of the present invention using the references quoted by the Examiner. This motivation could be provided by the references quoted by the Examiner or generally available to the public. The Examiner failed to present any of such evidence to establish a *prima facie* case of obviousness of claims 1-34 of the present invention.

Moreover, the Examiner's reference to "in order for a terminal in Kalke's system to send a request to a

portal server based on specified address" (section 9 of the final Office Action of May 14, 2007), or to "increasing security" (section 11 of the final Office Action of May 14, 2007) for combining references is irrelevant because this has nothing to do with the invention disclosed in claims 1 (and other independent claims) of the present patent application, i.e., with the problem to be solved by the present invention which is "plug and play" methodology for configuring the terminal (e.g., by establishing a chain of trust using plug and play method). None of the references quoted by the Examiner talk, teach or even hint about that "plug and play" methodology (the references quoted by the Examiner have completely different goals and "problems to be solved"), such that combining the references quoted by the Examiner would not make any sense to arrive at the subject matter recited in the independent claims 1, 19, 36 and 38 of the present invention.

In other words, the Examiner practically uses "shared advantage" approach such as achieving competitive advantage or economical advantage (which can make any invention obvious) irrelevant to the "problem to be solved" by the present invention, contrary to what is instructed by the MPEP procedure.

The Manual of Patent Examining Procedure (the MPEP) clearly refers to the "problem to be solved" approach and cites a relatively recent Federal Circuit case supporting its use:

"The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a

whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). MPEP 2143.01.

Also the Court of Appeals for the Federal Circuit, provided as to the circumstances under which the "problem to be solved" approach should be applied, and, more specifically, that the test for an *implicit* showing requires that the "problem to be solved" test be satisfied. See *In re Rinehart* at 149; *Pro-Mold* at 1630; *In re Rouffet* at 1458; *Para-Ordinance* at 1240; *In re Oetiker* at 1446-1447.

It is followed from the above arguments that that the Examiner disregard these MPEP guidelines and recent Court decisions regarding "problem to be solved" when defining a motivation to combine the references of Kalke, Muramatsu et al. and Martin et al.

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The rejections of the Official Action of May 14, 2007,  
having been obviated or shown to be inapplicable,  
withdrawal thereof is requested, and passage of claims 1-41  
to issue is solicited.

Respectfully submitted,



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